

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 17, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Objections

Claims 23 has been objected to for containing an informality. In response to the objection, Applicant has amended claim 23 to change “is” to “its” as recommended by the Examiner. In view of that claim amendment, Applicant respectfully submits that the claim is not objectionable and respectfully requests that the objection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 101

Claims 31-37 have been rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

In response to the rejection, Applicant has amended independent claims 31, 34, and 36 so as to be drawn to a “computer-readable medium” instead of a “program.” In view of those amendments, Applicant respectfully submits that claims 31-37 are directed to statutory subject matter as defined by 35 U.S.C. § 101 and therefore respectfully requests that the rejection be withdrawn.

III. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 11, 16, and 23 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In regard to claim 11 and 16, it is argued that the use of the word “it” is ambiguous. In response, Applicant has amended claims 11 and 16 to avoid use of the word “it”.

In regard to claim 23, it is argued that Applicant’s recitation of a “processing device” is indefinite because “[i]t is uncertain as to what this processing device does.” In response, Applicant notes that the “uncertainty” as to what the processing device does pertains to the claim’s breadth, not its clarity. Specifically, that the function of the processing device is not explicit in claim 23 means that the claim is broad as to that aspect. That does not mean, however, that the claim is indefinite.

In view of the above, it is respectfully asserted that the claims define the invention in the manner required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejections to these claims be withdrawn.

IV. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The

Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A. Rejection of Claims 6-8, 10, 11, 13-16, and 23-37

Claims 6-8, 10, 11, 13-16, and 23-37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tanimoto* (U.S. Pat. No. 6,963,419) in view of *Sugiyama* (U.S. Pat. No. 6,965,958). Applicant respectfully traverses this rejection.

1. The Tanimoto Disclosure

Tanimoto discloses a facsimile apparatus and communication method. *Tanimoto*, Patent Title. In disclosing his invention, Tanimoto describes a system in which a client computer 4, which is depicted as a desktop computer, is connected to network 5. *Tanimoto*, column 4, lines 14-17. As

indicated in the Office Action, the client computer 4 can receive a encrypted information from a facsimile server 1 via the network 5. *Tanimoto*, column 5, lines 4-9; column 4, lines 33-39.

Significantly, the Tanimoto reference says *nothing* about transmitting data from a printer to a portable computing device for the purpose of having the portable computing device unprotect and/or translate the data.

2. The Sugiyama Disclosure

Sugiyama discloses a method for searching for printers over a network. Sugiyama, Patent Title. Like the Tanimoto reference, the Sugiyama reference says *nothing* about transmitting data from a printer to a portable computing device for the purpose of having the portable computing device unprotect and/or translate the data.

3. Discussion of Applicant's Claims

Beginning with independent claim 6, Applicant claims (emphasis):

6. A method for facilitating secure printing, comprising:
receiving with a portable computing device a protected document from a nearby printing device;
unprotecting the document on the portable computing device; and
transmitting the unprotected document from the portable computing device back to the printing device so that the printing device can generate a hard copy of the document.

As can be appreciated from the clear language of claim 6, Applicant claims a method in which: (i) a portable computing device receives a protected document from a nearby printing

device, (ii) the portable computing device unprotects the document; and (iii) the portable computing device transmits the unprotected document back to the printer. Neither the Tanimoto nor the Sugiyama reference teaches anything remotely close to such a method.

In the Office Action, the Examiner takes Official Notice that “replacing the client computer with a laptop or PDA for computing and displaying image data is well known in the art.” Applicant objects to the Examiner’s use of Official Notice in this instance. Although it is easy to treat all computing devices as interchangeable, the Examiner is ignoring the context of the claim. Although one may consider a desktop computer and a laptop computer to be substantially equivalent when the task to be performed is simply creating a document, the context of claim 6 is far different. Specifically, the recited use of the “portable computing device” recited in claim 6 is not one that is common. Indeed, it is clear that receiving a protected document with a portable computing device from a printer, translating the document with the portable computing device, and then returning a translated version of the document to the printer is quite unique and, to Applicant’s knowledge, was never contemplated by the prior art. In actuality, the Examiner is taking Official Notice of the actions recited in claim 6 being performed by a portable computing device. Such Official Notice is clearly unwarranted.

More generally, Applicant objects to the rejection on the basis that the Examiner is rejecting claim 6 in a piecemeal fashion. As is well established in the law, the Examiner must instead consider the claims as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, “the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed”). When one considers claim 6 as a whole, it becomes

exceedingly clear that the claimed method would not have been obvious in view of the Tanimoto and Sugiyama disclosures.

As stated above, the Tanimoto reference simply teaches receiving an encrypted file with a desktop computer via a network. Applicant acknowledges that such an action is known in the art. The Sugiyama reference is relied upon for simply teaching transmitting a document to a printer for printing. Applicant acknowledges that that action is also known in the art. Applicant questions, however, how those two teachings somehow render obvious the method of: (i) a portable computing device receiving a protected document from a nearby printing device, (ii) the portable computing device unprotecting the document; and (iii) the portable computing device transmitting the unprotected document back to the printer. Clearly, Tanimoto's and Sugiyama's teachings would not lead a person having ordinary skill in the art to Applicant's claimed method in given that neither describe a process that is even remotely similar to that described in claim 6.

Not only is receiving a protected document and unprotecting the document on a portable computing device not obvious in view of the Tanimoto and Sugiyama references, Applicant notes that the general process of receiving a protected document from a printer and returning an unprotected version to the printer is not obvious in view of those references. Again, Tanimoto and Sugiyama separately teach (a) receiving a protected document on a computer, and (b) sending document to a printer for printing. Missing from the references, however, is a teaching or suggestion of a printer providing a protected document to another device for the purpose of that device unprotecting the document for the printer. Such a concept is just not contemplated by Tanimoto or Sugiyama.

In view of the above, Applicant submits that claim 6 and its dependents are clearly allowable over the Tanimoto/Sugiyama combination. Applicant notes that claims 18, 25, and 34,

which also discuss unprotecting of protected documents, are allowable for at least the same reasons as those mentioned above.

Turning next to independent claim 13, Applicant claims (emphasis added):

13. A method for facilitating secure printing, comprising:
receiving with a portable computing device an *untranslated document in a non-print ready format* from a nearby printing device;
translating the document into a print ready format on the portable computing device; and
transmitting the translated document from the portable computing device back to the printing device so that the printing device can generate a hard copy of the document.

Applicant notes that the reasons for patentability over the Tanimoto and Sugiyama references stated above in relation to claim 6 generally apply to claim 13 and the other independent claims that describe translating untranslated documents. In particular, the Tanimoto and Sugiyama references do not render the claims obvious when the claims are considered as a whole.

As a further matter, Applicant objects to the interpretation of the term “untranslated document” used by the Examiner. In relation to claim 13, the Examiner argues that Tanimoto teaches receiving an untranslated document and translating the document by “decrypting” the document. Such an interpretation is clearly contrary to the plain and ordinary meaning of the term “translation” as used in the printing arts and further is contrary to the definition of the term “translation” provided by Applicant’s disclosure. As to the latter point, Applicant clearly distinguishes between decrypting and translating in Applicant’s specification. The term “translating” is clearly described as translating a document from a non-print ready form, such as a

Word document, into a print ready form that a printer can process. As is well known in the art, that translation is normally performed by a driver that resides on the computer that sends the document to the printer, whether it be the user's PC or an intermediate print server. Nowhere, however, is that translation equated to decrypting. In fact, Applicant separately discusses decrypting as a distinct form of document processing that can be performed. Therefore, Applicant has clearly defined the meaning of "translating" and has established that it is not "decrypting." Applicant notes for the record that it is well established in the law that claim terms *are to be interpreted in light of the specification*. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification, of which they are a part").

Applicant has amended claim 13 and other independent claims pending in the instant application in an effort to clarify that the translation identified in the claims is not decryption. For example, claim 13 now recites receiving an untranslated document "in a non-print ready format" and translating the document into a print ready format. Applicant submits that a person having ordinary skill in the printing arts could not reasonably interpret such translating as performing decryption.

In view of the above, Applicant submits that claim 13 and its dependents are allowable over the Tanimoto and Sugiyama references. Applicant notes that claims 23, 28, 31 and 36, which also discuss translating untranslated documents, are allowable for at least the same reasons as those mentioned above.

B. Rejection of Claims 1, 3, and 5

Claims 1, 3, and 5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tanimoto* in view of *Kageyaman, et al.* ("Kageyaman," U.S. Pat. No. 6,567,180) and further in view of *Sugiyama*. Applicant respectfully traverses this rejection.

As is identified above, Tanimoto and Sugiyama do not teach several aspects of Applicant's invention. In that Kageyaman does not remedy the deficiencies of the Tanimoto and Sugiyama references, Applicant respectfully submits that claims 1, 3, and 5 are allowable over the Tanimoto/Kageyaman/Sugiyama combination for at least the same reasons stated above. Specifically, Tanimoto and Sugiyama do not teach or suggest the method of claim 1 when the claim is considered as a whole. Furthermore, neither reference teaches or suggests translating an untranslated document for reasons described in the foregoing.

V. Canceled Claims

Claims 2, 4, 9, 12, 17, and 19 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

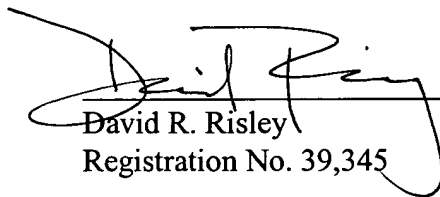
VI. New Claims

Claims 38-47 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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